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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,884	12/22/2003	Yizhong Gu	01492.US1	9782
25533 75	590 10/19/2005		EXAMINER	
PHARMACIA & UPJOHN			FRONDA, CHRISTIAN L	
301 HENRIET	ΓA ST		ART UNIT	PAPER NUMBER
0228-32-LAW			AKI ONII	FAFER NOMBER
KALAMAZOO, MI 49007			1652	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
Office Action Commons	10/743,884	GU, YIZHONG				
Office Action Summary	Examiner	Art Unit				
	Christian L. Fronda	1652				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).						
Status						
1) Responsive to communication(s) filed on	<u>_</u> .					
2a) This action is FINAL . 2b) This	This action is FINAL. 2b) This action is non-final.					
3) ☐ Since this application is in condition for allowar	nce except for formal matters, pro	secution as to the merits is				
closed in accordance with the practice under E	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.					
Disposition of Claims						
4)⊠ Claim(s) <u>1-21</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.						
6)☐ Claim(s) is/are rejected.						
7) Claim(s) is/are objected to.						
8) Claim(s) <u>1-21</u> are subject to restriction and/or e	election requirement.					
Application Papers						
9) The specification is objected to by the Examiner.						
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.						
Priority under 35 U.S.C. § 119						
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 						
3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
Attachment(s)						
1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) 2) Paper No(s)/Mail Date						
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	5) Notice of Informal Pa	te atent Application (PTO-152)				

DETAILED ACTION

Election/Restriction

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1, drawn to an isolated enoyl-coA-hydratase: 3-hydroxyacyl-coA dehydrogenase bifunctional enzyme (L-PBE), classified in class 435, subclass 189.
 - II. Claims 2-5, drawn to an antibody, classified in class 530, subclass 387.1.
 - III. Claims 6-9 and 10, drawn to an isolated polynucleotide and any array of nucleic acid molecules comprising said isolated polynucleotide, classified in class 536, subclass 23.2.
 - IV. Claim 12, drawn to a method for determining the amount of canine L-PBE polynucleotide present within a sample, classified in class 435, subclass 6.
 - V. Claims 13-16, drawn to a method for measuring the metabolic response to a test agent in a dog comprising determining the amount of polynucloetide of SEQ ID NO: 1, classified in class 435, subclass 6.
 - VI. Claims 17-19, drawn to a method for determining the amount of canine L-PBE polypeptide present within a sample, classified in class 435, subclass 7.4.
 - VII. Claims 20 and 21, drawn to a method for measuring the metabolic response to a test agent in a dog comprising determining the amount of polypeptide of SEQ ID NO: 22, classified in class 435, subclass 7.1.
- 2. The inventions are distinct, each from the other because of the following reasons:
 Inventions of Groups I, II, and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Each of the products of Groups I, II, and III are different and independent products and require different literature.

Inventions of Groups V-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The processes of Groups V-VII are distinct both physically and functionally; require different process steps, reagents, and parameters; and have different purposes.

Inventions of Groups IV and V are unrelated to the invention of Groups I and II. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The processes of Groups IV and V do not require the products of Groups I and II.

Inventions of Groups VI and VII are unrelated to the invention of Groups I and III. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The processes of Groups VI and VII do not require the products of Groups I and III.

Groups III and IV/V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as a process of using the isolated polynucleotide in a recombinant process to make a enoyl-coA-hydratase:3-hydroxyacyl-coA dehydrogenase bifunctional enzyme. Furthermore, searching the invention of Groups III-V together would impose a serious search burden because each of the inventions require separate searches which have different limits, boundaries, scope, and subject matter.

Groups II and VI/VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as a process of using the antibody as an affinity tag in a chromatography method for isolating and purifying the L-PBE. Furthermore, searching the invention of Groups II, VI, and VII together would impose a serious search burden because each of the inventions require separate searches which have different limits, boundaries, scope, and subject matter.

Because these inventions are distinct for the reasons given above and have acquired a

separate status in the art because of their recognized divergent subject matter and classification, restriction for examination purposes as indicated is proper.

3. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

4. A telephone call was made to Thomas Wootton on 05/20/2005, to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L Fronda whose telephone number is (571)272-0929. The

examiner can normally be reached Monday-Friday between 9:00AM - 5:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura N Achutamurthy can be reached on (571)272-0928. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christian L. Fronda Patent Examiner Art Unit 1652 Manjunath Rao
Primary Patent Examiner
Art Unit 1652